

## **Remarks**

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings.

### ***Finality of the Office Action***

The RCE filed on April 1, 2008 included a request for a three month suspension pursuant to 37 CFR 1.103(c). Accordingly, applicant had until July 1, 2008 to file a reply to the final Office Action dated October 1, 2007. The latest Office Action was issued on June 27, 2008, which is prior to the end of the suspension period. Moreover, the Office Action was made final.

In view of the premature issuance of the latest Office Action, the finality of said Office Action should be withdrawn and the above amendments entered as a matter of right. Moreover, the next Office Action should not be made final (should there be a next Office Action) since applicants are entitled to consideration of the herein amended claims and the opportunity to introduce new amendments should this be necessary in view of any new rejections that may be advanced by the Examiner.

### ***Oath/Declaration***

The Examiner's attention is invited to the Office notice at 1327 OG 110 entitled "Duty of Disclosure Language Set Forth in Oaths or Declarations Filed in Nonprovisional Patent Applications". This notice waived the requirement for a new declaration.

### ***Claim Rejections - 35 USC § 102 and § 103***

The claims stand rejected with primary reliance on U.S. Patent No. 4,305,394 ("Bertuch"). In view of the foregoing amendments, the rejections of claim 1 and the claims depended therefrom are moot.

Regarding amended claim 1, the claimed system for positioning an implant comprises, inter alia, a tensioning device proximate the first end that is configured to move axially the holding element after an implant has been connected to the second end of the holding element so as to move the implant into abutment with an adjacent end of the guiding sleeve and place the elongated intermediate portion under tension. This feature is discussed in the paragraph spanning pages 10 and 11 of applicants' specification. An examination of Bertuch will review the absence of any structure similar

to the tensioning device recited in amended claim 1. The same can be said for U.S. Patent No. 5,320,625 ("Bertin").

For at least the foregoing reason, the rejection of claim 1 should be withdrawn, as should the rejection of any claim depending from claim 1.

Also by way of the foregoing amendments, claim 14 has been amended to include the features of claim 15, as well as to delete a limitation calling for rotational as well as translatable movement of the holding element. As previously pointed out, the claimed navigation element is a completely different element from the prosthesis orientation bar 102 disposed on a pair of prosthesis orientation legs 104, 106, which is disclosed in Bertin. As such, neither Bertuch nor Bertin discloses or fairly suggests the claimed navigation element as recited in claim 14.

Regarding the Examiner's Response to Arguments concerning a navigation system not being recited as part of the claim, the alleged navigational element of Bertin does not comprise anything akin to navigational markers, each of which is trackable by a navigation system.

For at least these reasons, the rejection of claim 14 should be withdrawn.

### ***Conclusion***

In view of the foregoing, request is made for timely issuance of a notice of allowance.

Respectfully submitted,

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